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09/464,866	12/16/1999	RICHARD BRYAN SAGAR	PHA-23.884	8189

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PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
CORPORATE INTELLECTUAL PROPERTY
1000 WEST MAUDE AVE
SUNNYVALE, CA 94085

EXAMINER

D AGOSTA, STEPHEN M

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 09/24/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/464,866

Applicant(s)

SAGAR, RICHARD BRYAN

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

In view of the appeal brief filed on 9-8-03, PROSECUTION IS HEREBY REOPENED. A new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

- a. New art cited continues to read on the claims.
- b. The number of patents cited has been reduced. Considerable "prior art made of record and not relied upon considered pertinent to applicant's disclosure" is also attached.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-15 rejected under 35 U.S.C. 103(a) being unpatentable over Bauer US 5,870,759 in view of Brunson US 5,647,002 or Alley et al. U.S. Patent 5,845,282 (hereafter referred to as Bauer, Brunson or Alley).

As per **claim 1**, Bauer teaches a method of selecting and retrieving computer data files in a first database of a first electronic apparatus to a second apparatus, comprising;

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- uploading the information from the first apparatus to a server that is remote from the first apparatus – the information stored in a first database of the first apparatus for use in the first apparatus and the server accessible by a second apparatus that is remote from the first apparatus and the server,

- determining whether the information is more recent than a copy of the information stored on the server
- updating the copy of the information with the uploaded information, if it is determined that the uploaded information is more recent
- manipulating the information at the server; and
- downloading the manipulated information from the server to the second apparatus for storage in a second data base of the second apparatus for use in the second apparatus.

- wherein the manipulated information can be automatically entered into the second database for use by an application in the second apparatus (Abstract teaches a synchronization server and updates performed said server are propagated to the clients when a connection is established and eventually from the server to other clients in the system, figures 1-6b and C1, L5-49, C2, L48 C3, L2). Note that **Brunson** discloses the fact that the database application may not be the same for all users (C1, L29-36) which provides motivation for the system to be used with disparate databases.

but is silent on requiring a predetermined data format regardless of communication compatibility between the first apparatus and the second apparatus.

Brunson teaches a synchronization of two different types of systems whereby the synchronization server/hardware automatically synchronizes both systems in message content and in message state even though both systems have different data structures and carry information expressed in different media and having different formats (abstract). Further to this point is **Alley** who teaches synchronization between a computer and a server (abstract, C2, L31-44, C2, L63-67 to C3, L1-10).

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that different systems can be synchronized, to provide means for a user's data to be synchronized among other disparate systems.

As per **claim 2**, Bauer teaches claim 1, further comprising a user utilizing a pen-based hand-held computer can connect to a remote computer and download data to the hand-held for storage (C6, L40-46 – teaches hand-held computer/PDA's which are known to be pen-based).

As per **claim 3**, Bauer teaches the method of claim 1, wherein each of the first and second apparatus comprises at least one of the following: a PDA, Internet capability, mobile or wired phone (C6, L40-60 teaches computer, laptop, handheld/PDA, phone network, analog modem/Internet, cellular/digital modem, infrared), **but is silent on a pager**.

Alley teaches synchronization and use of a pager (C6, L40).

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It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that a pager is supported, to allow for the user to be alerted if/when a synchronization of data files is to occur or has happened.

As per **claim 6**, Bauer teaches the method of claim 1, wherein the server keeps a copy of the information uploaded (abstract - the database server/synchronizer stores the data used by the clients).

As per **claim 7**, Bauer teaches the method of claim 1, **but is silent on** selectively extracting data from the uploaded information and converting a format.

Alley teaches "manipulating" which comprises converting the format of the data (C3, L7-10) and the ability of selectively extracting data from the uploaded information (C10, L24-34 – Alley allows for many different functions to be performed. Thus "selectively extracting data" is a function that would be apparent to one skilled in the art). Further to this point is **Brunson** which provides for automatic synchronization and reformatting of data between two different systems.

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that data is selectively extracted and converted, to provide means for a user to only choose certain things to update while not updating others.

As per **claim 8**, Bauer teaches a method of a method of selecting and retrieving computer data files from a remote computer and providing a service for enabling to transfer information in a first database of a first electronic apparatus to a second apparatus comprises:

- enabling to upload the information from the first apparatus to a server that is remote from the first apparatus, the information stored in a first database of the first apparatus for use in the first apparatus and the server accessible by a second apparatus that is remote from the first apparatus and the server.

- enabling to determine whether the information is more recent than a copy of the information stored on the server
- updating the copy of the information with the uploaded information, if it is determined that the uploaded information is more recent
- enabling to manipulate the information at the server;
- enabling to download the manipulated information from the server to the second apparatus for storage in a second data base of the second apparatus for use in the second apparatus
- wherein the manipulated information can be automatically entered into the second database for use by an application in the second apparatus

(Abstract teaches a synchronization server and updates performed said server are propagated to the clients when a connection is established and eventually from the server to other clients in the system, figures 1-6b and C1, L5-49, C2, L48 C3, L2). Note that Brunson discloses the fact that the database application may not be the same for all users (C1, L29-36) which provides motivation for the system to be used with disparate databases.

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but is silent on requiring a predetermined data format regardless of communication compatibility between the first apparatus and the second apparatus.

Brunson teaches a synchronization of two different types of systems whereby the synchronization server/hardware automatically synchronizes both systems in message content and in message state even though both systems have different data structures and carry information expressed in different media and having different formats (abstract). Further to this point is **Alley** who teaches synchronization between a computer and a server (abstract, C2, L31-44, C2, L63-67 to C3, L1-10).

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that different systems can be synchronized, to provide means for a user's data to be synchronized among other disparate systems.

As per **claim 9**, Bauer teaches the method of claim 1, **but is silent on** selectively extracting data from the uploaded information and converting a format.

Alley teaches "manipulating" which comprises converting the format of the data (C3, L7-10) and the ability of selectively extracting data from the uploaded information (C10, L24-34 – Alley allows for many different functions to be performed. Thus "selectively extracting data" is a function that would be apparent to one skilled in the art). Further to this point is **Brunson** which provides for automatic synchronization and reformatting of data between two different systems.

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that data is selectively extracted and converted, to provide means for a user to only choose certain things to update while not updating others.

As per **claim 10**, Bauer teaches the method of 8, wherein a user utilizing a pen-based hand-held computer can connect to a remote computer and download data to the hand-held for storage (C6, L40-60).

But is silent on first/second communications directories.

Alley shows the connection phase (figure 10a), the display of various directories and files on the remote computer (figure 10B) and the selection of a specific file on the remote computer (figure 10C).

Alley also discusses the trend whereby personal organizers are gaining popularity and can perform functions such as keeping a calendar, address book, to-do list, etc. (C1, L20-30). Hence, the examiner assumes that both the hand-held and remote computer can have at least a first and second communications capability and a first and second database (eg. the first apparatus performs first communications functionalities using data stored in the first data base AND the second apparatus performs second communications functionalities using data stored in the second database – the applicant teaches the NinoTM while Alley teaches the Apple NewtonTM which can store a database and communications preferences such as phone numbers and modem/IR parameters (C1, L31-38 and figure 1 shows PCMCIA and IR interfaces [C6, L32-62]). Alley specifically states that directories can be accessed/downloaded (figure 10B) and that these directories can relate to many different purposes (eg. the first data base relates to a first communications directory AND the second data base

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relates to a second communications directory – note that Alley and the applicant's databases store similar data [ref. applicant's specification page 2, Lines 18-20]).

Lastly, Alley discusses data downloads in a "generic" sense and therefore the examiner interprets that any data which is capable of being stored in the remote computer can be downloaded to the hand-held computer without restriction.

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that communication directories are used, to provide means for storing various pieces of data in different directories.

As per **claim 11**, Bauer teaches a method for transferring data in a database of a first mobile terminal (eg. first mobile terminal) to a second mobile terminal (C6, L40-60 teaches cellular modems), comprising a method for transferring data from a first computer system with a first operating system to a second computer system (abstract)

Uploading data from the first application's database to a common server

Associating data with a particular user (abstract teaches uploading and client databases which are associated with each user, C6, L6-39. Also commercial databases from Oracle, Microsoft as cited by Bauer provide this capability).

Determining a format required by the user

Converting the uploaded data to conform to the format

Downloading the converted data automatically into the second database for use by the second application.

Brunson teaches a synchronization of two different types of systems whereby the synchronization server/hardware automatically synchronizes both systems in message content and in message state even though both systems have different data structures and carry information expressed in different media and having different formats (abstract). Further to this point is **Alley** who teaches synchronization between a computer and a server (abstract, C2, L31-44, C2, L63-67 to C3, L1-10).

It would have been obvious to one skilled in the art at the time of the invention to modify , such that

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that information is uploaded to a server from a first apparatus and operating system and then downloaded to a second apparatus with a different operating system, to allow the information to be sent to an intermediate server so that only one server/program is required to serve data which reduces the number of servers/programs which need to be setup and allows disparate systems to communicate (also provides for secondary, offsite backup of data).

As per **claims 12-13**, Bauer teaches the method of claim 11 **but is silent on** wherein the first/second database includes data from a Calendar and/or Personal Information Manager (C2, L6-9) which would include a telephone directory.

Alley teaches a database that includes data from a Calendar and/or Personal Information Manager (C2, L6-9) which would include a telephone directory.

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It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that data stored is telephone data, to provide means for storing contact information.

As per **claim 14**, Bauer teaches the method of claim 11 wherein the first apparatus and the second apparatus includes one or more of a PDA and cell phone (C6, L40-60) **but silent on** a pager.

Alley teaches use of a pager (C6, L40).

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that a pager is supported, to allow for the user to be alerted if/when a synchronization of data files is to occur or has happened.

As per **claim 15**, Bauer teaches the method of claim 1 and updates being propagated to the other side when a connection is established (which reads on and automatically retrievable by the second apparatus to initiate a telephone call from the second apparatus) **but is silent on** wherein the manipulated information includes data from a Calendar or Personal Information Manager [C2, L6-9] (eg. one or more telephone numbers).

Alley teaches manipulated information includes data from a Calendar or Personal Information Manager [C2, L6-9] (eg. one or more telephone numbers).

The examiner also notes that many programs today have been automated to remove the need for user interaction, especially for mundane tasks such as updating/synchronizing files. Well known automated programs such as Microsoft Outlook and Briefcase provide automatic synchronization of data files so that the user does not have to either remember to check for new email (Outlook) and/or upload changes made during the day (Briefcase). Alley teaches a Calendar program that is a program under the Microsoft umbrella and would be an excellent reason as to why automatic updates would be obvious (eg. the user roams all day and inputs data to the Calendar or PIM program. Late in the day the user's desktop PC initiates a call to the PDA for data download/synchronization).

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that data is automatically retrievable by the second apparatus to initiate a telephone call from the second apparatus for Calendar/PIM data, to provide automated downloads/synchronization that don't require user intervention and always keeps data up-to-date.

Claims 4-5 rejected under 35 U.S.C. 103(a) being unpatentable over

Bauer/Brunson or Alley and further in view of Nishino 6,233,452 (hereafter referred to as Nishino).

As per **claim 4**, Bauer teaches the method of claim 1, **but is silent on** wherein the information is uploaded via the Internet from the first apparatus to the server.

The examiner interprets Bauer's teachings of analog/digital modems as being used to connect to the Internet (C6, L40-60). As is known in the art, a server connected

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to the Internet will allow a user to connect to it from anywhere in the world via local call to an ISP (which reduces cost).

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that information can be uploaded via the Internet, to provide for cheaper access costs (eg. local call to ISP) and worldwide access.

As per **claim 5**, Bauer teaches the method of claim 1, **but is silent on** wherein the information is downloaded via the Internet to the second apparatus.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Bauer, such that information can be downloaded via the Internet, to provide for cheaper access costs (eg. local call to ISP) and worldwide access.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


1. Mendez et al. US 5,961,590 teaches synchronization for email.
2. Pivowar et al. US 6,308,201 teaches sharing data among PDA's.
3. Meyering US 5,729,735 teaches database synchronization.
4. Mendez et al. US 6,023,708 teaches global synchronization.
5. Mendez US 6,151,606 teaches data manager for synchronization
6. Kaufman US 6,034,621 teaches PDA-to-PC synchronization.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist on 703-306-0377.

SMD
9-12-03


WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600